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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,529	03/15/2001	William A. Spalding	194-26331-US	4526
23770	7590	03/29/2004	EXAMINER	
PAULA D. MORRIS & ASSOCIATES, P.C. 10260 WESTHEIMER, SUITE 360 HOUSTON, TX 77042			METZMAIER, DANIEL S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,529

Applicant(s)

SPALDING, WILLIAM A.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 144, 145, 147-150 and 152-213 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 144, 145, 147-153, 156-185, 187, 189, 191, 199, 200, 202, 203, 206 and 211-213 is/are allowed.
- 6) ☒ Claim(s) 155, 186, 188, 190, 192, 198, 201, 204, 205 and 207-210 is/are rejected.
- 7) ☒ Claim(s) 154 and 193-197 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 144, 145, 147-150 and 152-213 are pending.

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The following issues remain.

Claim Objections

2. Claims 154 and 193-198 are objected to because of the following informalities: claims 154 and 193-198 contain what appears to be residual deletions from previous amendments. Applicants should check these and all claims so that they conform to 37 CFR 1.121 and present a complete set of claims if the correction of any of said subject matter is not intended to be printed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 155, 186, 188, 190, 192, 198, 201, 204, 205, 207, 208, 209 and 210 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 155 is dependent on claim 144, which sets forth a specific structure for nonionic surfactants defining alkyl ethers. Claim 155 sets forth tall oil ethoxyethoxylates, ethoxylated nonylphenols, and phosphated fatty alcohol ethoxylates. None of said

materials fall within the structure set forth in independent claim 144. Tall oil is defined as a mixture of rosin acids and fatty acids, which when ethoxylated would produce an ester group not found in the structure of claim 144. Nonylphenol is an alkylaryl rather than an alkyl group. Phosphated structures are not provided for in the structure of claim 144. Furthermore, the term "polyoxyalcohols" is broader than the structure of claim 144 since the structures defined more specific polyoxyalcohols. It is unclear what is the scope of said claims and if the components are further components of the nonionic surfactant.

A similar relationship exist with regard to claims 188, 190, and 192. The claims dependent on claims 192 are objected because of the above noted issue.

Claim 207 defines the mutual organic solvent as specific glycol ethers and is dependent on claim 183, which sets forth the "said mutual organic solvent is selected from the group consisting of water soluble propylene glycol ethers, N,N-dimethylformamide, N,N-dimethylacetamide, 1-methyl-2-pyrrolidinone, acetone, methanol, ethanol, 1-propanol and 2-propanol". It is unclear what is the scope of said claims to glycol ethers and if the components are further components of the mutual solvents.

Claims 208, 209 and 210, define the mutual organic solvent as specific glycol ethers is indirectly dependent on claim 184, which sets forth the "said mutual organic solvent is selected from the group consisting of water soluble propylene glycol ethers, N,N-dimethylformamide, N,N-dimethylacetamide, 1-methyl-2-pyrrolidinone, acetone, methanol, ethanol, 1-propanol and 2-propanol". It is unclear what is the scope of said

claims to glycol ethers and if the components are further components of the mutual solvents.

Applicants should review all the 65 claims presented to make them conform to proper claim drafting. It is noted that several sets of claims are presented having varying scope as a result of the prosecution history.

Allowable Subject Matter


5. Claims 144, 145, 147-153, 156-185, 187, 189, 191, 199-200, 202-203, 206 and 211-213 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM